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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,387	02/18/2004	J. Michael Rivera	022050-000100US	4345
20350 7590 01/08/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER BATTULA, PRADEEP CHOUDARY	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 01/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/782,387

Applicant(s)

RIVERA ET AL.

Examiner

Pradeep C. Battula

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 14-19, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 14-19, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 12, 2007 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 14, 19, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu and Sharpe et al. (Sharpe; U.S. 5,626,702). In regards to Claim 1, Kamen discloses a method of attaching a film to printed matter, comprising: printing a pattern on a substrate with UV curable ink (Column 1, Lines 50 – 55; Column 3, Lines 1 – 6); placing a film over said pattern (Column 1, Lines 57 – 61); and curing said UV curable ink with UV light (Column 1, Line 56; Column 3, Lines 1 – 6); wherein said curing causes said holographic film to stick to said pattern without the

need for an adhesive layer (Column 1, Lines 59 – 61; foil adhered to adhesive ink and nothing else).

Kamen does not disclose the film is a holographic film and the UV curable ink is in an uncured state before the holographic film is placed over the ink.

Osamu discloses a method of attaching a hologram film to printed matter, comprising: printing a pattern on a substrate 3 with UV curable ink (Section 0005, Lines 1 – 10); placing a holographic film (5, 8) over said pattern (Section 0005, Lines 13 – 16); and curing said UV curable ink 4 with UV light (Section 0010, Lines 1 – 4; Generally known in art that UV ink is hardened by light; Section 0010, Lines 5 – 15; also cured with heat rollers); wherein said curing causes said holographic film to stick to said pattern (Section 0010, Lines 5 – 15; Figure 1, Item 5; Figure 2, Items 2, 4, 8). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to substitute Osamu's film for Kamen's film in order to provide a more decorative coating to Kamen's substrate (Column 1, Lines 9 – 10, 45 – 47; Kamen).

Kamen modified by Osamu does not disclose the UV curable ink is in an uncured state before the holographic film is placed over the ink.

Sharpe discloses of providing an uncured adhesive to a substrate and then applying a holographic foil to the uncured adhesive (Column 3, Lines 34 – 52). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the adhesive of Kamen modified by Osamu in

an uncured state and then apply the holographic foil in order to apply the holographic film directly to the substrate and adhesive as taught by Sharpe.

In regards to Claim 14, Kamen discloses a substrate (Column 1, Lines 51 – 55); a pattern of UV cured ink on said substrate (Column 1, Line 56; Column 3, Lines 1 – 6); and a film over said pattern (Column 1, Lines 57 – 61), adhering to the cured ink of said pattern without the need for an adhesive layer (Column 1, Lines 59 – 61; film adhered to adhesive ink and nothing else).

Kamen does not disclose the film is a holographic film and the UV curable ink is in an uncured state before the holographic film is placed over the ink.

Osamu discloses a security label comprising: a substrate 3 (Section 007, Lines 14 – 21); a pattern of UV cured ink 4 on said substrate (Section 0005, Lines 1 – 10; Figure 1, Items 3, 4); and a holographic film (5,8) over said pattern (Section 0005, Lines 13 – 16), adhering to the cured ink of said pattern (Section 0010, Lines 5 – 15; Figure 1, Item 5; Figure 2, Items 2, 4, 8). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to substitute Osamu's film for Kamen's film in order to provide a more decorative coating to Kamen's substrate (Column 1, Lines 9 – 10, 45 – 47; Kamen).

Kamen modified by Osamu does not disclose the UV curable ink is in an uncured state before the holographic film is placed over the ink.

Sharpe discloses of providing an uncured adhesive to a substrate and then applying a holographic foil to the uncured adhesive (Column 3, Lines 34 – 52).

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the adhesive of Kamen modified by Osamu in an uncured state and then apply the holographic foil in order to apply the holographic film directly to the substrate and adhesive as taught by Sharpe.

In regards to Claim 19, as applied to Claim 14, Kamen modified by Osamu and Sharpe further discloses wherein said UV cured ink has low adhesion properties (Column 2, Lines 20 – 22, 42 - 52; Kamen; If ingredients are added to improve adhesion then adhesive strength is not initially high).

In regards to Claim 25, as applied to Claim 1, Kamen modified by Osamu and Sharpe further discloses peeling off the portion of the holographic film not in contact with the UV curable ink (Column 3, Lines 7 – 16; Kamen).

In regards to Claim 26, as applied to Claim 14, Kamen modified by Osamu and Sharpe further discloses wherein said film is only adhered to said cured ink, other portions of said hologram film having been peeled away (Column 3, Lines 7 – 16; Kamen).

2. Claims 2 – 4, 15 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu, Sharpe and Howland et al. (Howland; U.S. 6,089,614).

In regards to Claims 2 – 4, as applied to Claim 1, Kamen modified by Osamu and Sharpe does not disclose wherein the UV curable ink has fluorescent, photo chromic, or thermo chromic properties.

Howland discloses a security device in which indicia that can be printed with UV curable ink (Column 7, Lines 19 – 21). Howland further discloses indicia as first and second indicia 7, 9 that can have thermo chromic, photo chromic, and fluorescent properties (Column 8, Lines 12 – 18). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with various properties in order to further enhance the decorative properties of Kamen modified by Osamu (areas in which there is no foil adhesive can be seen in the gaps).

In regards to Claims 15 – 17, as applied to Claim 14, please refer to the rejection for Claims 2 – 4.

3. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu, Sharpe and Roth (U.S. 5,889,084).

In regards to Claim 5, as applied to Claim 1, Kamen modified by Osamu and Sharpe does not disclose the UV curable ink has bi-chromic properties.

Roth discloses that it is well known in the art to have a UV curable ink that changes color, therefore having bi-chromic properties (Column 2, Lines 33 – 38). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with various properties in order to further enhance the decorative properties of Kamen modified by Osamu (areas in which there is no foil adhesive can be seen in the gaps).

In regards to Claim 18, as applied to Claim 14, please refer to the rejection for Claim 5.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamen in view of Osamu, Sharpe and Scarbrough et al. (Scarbrough; U.S. Pub 2004/0140665).

In regards to Claim 6, as applied to Claim 1, Kamen modified by Osamu and Sharpe does not disclose wherein the UV curable ink is scratch-off ink.

Scarbrough discloses an image with an illusion of three dimensions using opaque ink which is UV curable (Paragraph 0064, Lines 12 – 20). It is known to one with ordinary skill in the art that many opaque inks are scratch off. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have a UV curable ink with that is scratch off in order to allow easy removal of any unwanted decoration.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
January 2, 2008
Pradeep Battula


MONICA CARTER
SUPERVISORY PATENT EXAMINER